UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,371	09/04/2001	Hiroko Sukeda	H-991	1281

7590 11/04/2005	EXAMINER
MATTINGLY, STANGER & MALUR, P.C.	VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
3622	

MATTINGLY, STANGER & MALUR, P.C.
ATTORNEYS AT LAW
SUITE 370
1800 DIAGONAL ROAD
ALEXANDRIA, VA 22314

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04 September 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>04 September 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All   b) ☐ Some *   c) ☐ None of:

   1. ☒ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>09042001</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   Claim 6 objected to because of the following informalities:

Claim 6, lines 2 and 3 make a reference to the phrase "to accept return".

The phrase is indefinite in nature and the Examiner has interpreted this phrase to

include the return of the smart card to the program sponsor. The prosecution of

Claim 6 has been conducted with this interpretation in mind. Appropriate

correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-4, and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by

Sarbin et al. (U.S. Patent Number: 5,179,517).

Claim 1:   Sarbin discloses a smart card system, comprising:

A smart card(Fig 2, and Col 4, lines 13-18); and at least one terminal

which is accessible to said smart card (Col 4, lines 59-62), said smart card

comprising:

      a.   An I/O interface for exchanging data via said terminal. (Col 3, lines 50-64)

      b.   An operating system. (Col 3, line 50 – Col 4, line 3 and Col 6, lines 16-36)

      c.   An application program unit including:

      i.   A data storage unit, which includes game defining data and point data. (Col 6, line 48 – Col 7, line 7)

      ii.   A program execute unit which accesses said data storage unit and executes a game defined by said game defining data. (Col 6, lines 16-36)

      iii.   Wherein said point data is divided into first point data and second point data, a point input from outside through said I/O interface is stored in said first point data, and a point generated inside according to the result of executing the game is stored in said second point data (Col 7, lines 8-27; and Col 7, line 55 – Col 8 line 5). First point data represented by the value in field 98 of Fig. 5 (Debits/Credits) and second point data represented in field 102 of Fig. 5 (Bonus Data).

Claim 2:   Sarbin discloses a smart card comprising:

      A.   An I/O interface for input and output of data. (Col 3, lines 50-64)

  B. An operation system. (Col 3, line 50 – Col 4, line 3 and Col 6, lines 16-36)

  C. An application program unit including:

    a. A data storage unit which includes game defining data and point data. (Col 6, line 48 – Col 7, line 7)

    b. A program execute unit which accesses said data storage unit and executes a game defined by said game defining data. (Col 6, lines 16-36)

    c. Wherein said point data is divided into first point data and second point data, a point input from outside through said I/O interface is stored in said first point data, and a point generated inside according to the result of executing the game is stored in said second point data. (Col 7, lines 8-27; and Col 7, line 55 – Col 8 line 5). First point data represented by the value in field 98 of Fig. 5 (Debits/Credits) and second point data represented in field 102 of Fig. 5 (Bonus Data).

Claim 3: Sarbin discloses the smart card according to claim 2, wherein, when the value of points stored in the smart card is subject to an inquiry, the sum of the first point data and the second point data is returned. (Col 8, lines 6-13)

Claim 4:   Sarbin discloses the smart card according to claim 2, wherein,

when points are newly added to the smart card from the outside, a point value is added

to the first point data. (Col 5, lines 60-68)

Claim 7:   Sarbin discloses the smart card according to claim 2, wherein,

when a game is to be executed on the smart card, a point value determined

corresponding to the game to be executed is subtracted from the first point data, and if

the point value is greater than the first point data, the game cannot be executed. (Col 5,

lines 60-68 and Col 7, line 55 – Col 8, line 5). Due to the differentiation stated between

the debit and credit methods, utilization of the debit method would prevent execution

when the Debit/Credit field (98) did not contain a positive balance.

Claim 8:   Sarbin discloses the smart card according to claim 2, wherein,

when points are to be gained according to the result of executing game on the smart

card, a point value is added to the second point data (Col 7, lines 8-27). As a result of

executing the game, player bonus is increased when criteria such a coins played or

volume of play is utilized.

Claim 9:   Sarbin discloses the smart card according to claim 2, wherein log

data on processing of an application on the smart card is stored in the smart card and

the log data can be referred to from the outside. (Col 9, lines 36 – 45)

Claim 10:   Sarbin discloses the smart card system according to claim 1 wherein said terminal has a game execution function which enables execution of the game held in said smart card (Col 4, lines 47 – 58).

Claim 11:   Sarbin discloses the smart card system according to claim 10, wherein said game execution function can be selected whether to be provided or not (Col 4, lines 47-58).

Claim 12:   Sarbin discloses a method for providing a loyalty program using a smart card, comprising the steps of:

A.   Managing point data by an application program on the smart card. (Col 6, line 48 – Col 7, line 7)

B.   Issuing a point in response to a product purchase and adding the issued point to first point data in the smart card. (Col 5, lines 60-69)

C.   Generating a point in response to a result of playing a game loaded in the smart card and adding the generated point to second point data in the smart card. (Col 7, lines 8-27)

D.   Controlling to provide a game service according to a value of points in said first point data. (Col 5, lines 60-68 and Col 7, line 55 – Col 8, line 5).

Claim 13:   Sarbin discloses the method for providing a loyalty program according to claim 12, wherein the step of controlling to provide a service of playing the game includes the step of subtracting from said first point data a predetermined point

value corresponding to the game to be executed. (Col 5, lines 60-68 and Col 7, line 55 –

Col 8, line 5). Due to the differentiation stated between the debit and credit methods,

utilization of the debit method would prevent execution when the Debit/Credit field (98)

did not contain a positive balance.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sarbin et al (U.S. Patent Number: 5,179,517).

Claim 5:   Sarbin discloses the smart card according to claim 2, wherein,

when points are to be subtracted from the smart card to receive a service corresponding

to the value of the points, a point value is firstly subtracted from the second point data,

and also subtracted from the first point data if the point value in the second point data is

less than the points to be subtracted (Col 7, lines 28 – lines 54). While Sarbin does not

explicitly disclose the order of point subtraction relative to the two separate database

fields, including such functionality would have been obvious to one having ordinary skill

in the art at the time the invention was made to allow for the processing of discounts or

upgrades that have been awarded as a result of game play. One would have been

motivated to provide this functionality in order to provide customers with loyalty awards

that are more cost effective to provide than direct cash awards. As indicated the order

of point subtraction claimed would occur in the event the service provided is a discount

or upgrade (i.e. 25% off on the price of a meal or an upgrade from business class to first

class on an airline). The redemption of the discount or upgrade would result in the

Bonus Data field (102) in Fig 5. being decremented first in order to obtain the discount

and the data in the Debit/Credit field (98) being subsequently decremented for the

remaining price of the service. Admittedly the customer could pay for the remaining

balance for the service provided with cash or credit that would not reduce the

Debit/Credit field. However, the option to utilize the Debit/Credit field exists and its use

would result deductions as stated in the claim.

Claim 6:   Sarbin discloses the smart card according to claim 2, wherein,

when points are to be subtracted from the smart card to accept return, a point value is

firstly subtracted from the first point data, and also subtracted from the second point

data if the point value in the first point data is less than the point to be subtracted. While

Sarbin does not explicitly disclose the order of point subtraction relative to the two

separate database fields, including such functionality would have been obvious to one

having ordinary skill in the art at the time the invention was made to allow for the return

of the smart card and the redeeming of points earned for cash. One would have been

motivated to provide this functionality in order to provide customers with an incentive to

utilize the smart card in lieu of cash. When a customer returns their card to cash out, the order of point subtraction claimed would occur. The Debit/Credit field would be decremented in order to refund the card balance and the customer would then have the option of redeeming points in the Bonus Data field for other awards, including cash awards. Admittedly the customer could redeem the points in the Bonus Data field without redeeming the points in the Debit/Credit field, or redeem the points in the Bonus Data field prior to redeeming the points in the Debit/Credit field, however, the option to affect the return of points could be accomplished in the order claimed.
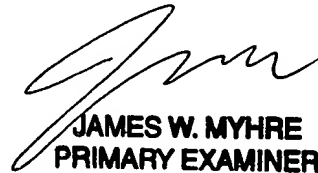
Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al. (U.S. Patent Number: 6,443,843) which discloses a loyalty program including game play with a fee. Walker et al. (U.S. Patent Number: 6,327,573) which discloses a reward system in which multiple accounts are present. Eggleston et al (U.S. Patent Number: 6,061,660) which discloses another loyalty program that incorporates both loyalty points and game play. Dave Birch (Multi-Application Smartcard Platforms, The Third Way, Hyperion Systems Limited, Nov. 14, 1998) which discloses many different smart card platforms and the ability to easily load multiple applications on smart cards.

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

·jvb
October 31, 2005

JAMES W. MYHRE
PRIMARY EXAMINER